

§Appl. No. 09/937,100  
Amdt. dated August 12, 2004  
Reply to Office Action of: November 10, 2004

## REMARKS

### Specification

A new abstract has been provided at the end of this paper.

An editable document was not readily available to Applicant; therefore, a substitute specification with appropriate line spacing has not been provided at this time. Applicant is now diligently trying to obtain one. It is therefore requested that the examiner hold this rejection in abeyance.

A revised sequence listing will be provided in due course to reflect the sequences on Pages 3, 5, and 26.

### Rejection under §112, second paragraph

The claims have been replaced with new claims, rendering moot the rejections under §112, second paragraph set forth in the Office action dated November 10, 2003. These new claims do not change the scope of the canceled claims, but merely clarify the subject matter that applicant intended to claim.

### Rejection under §101

As described in the specification, Applicant's invention provides "new methods for isolating specific proteins from a complex mixture of such proteins by virtue of binding to a specific target. In particular, the invention provides methods for isolating specific antibody domains from a gene library-derived mixture of such domains by virtue of binding to a specific target antigen. For the analysis of proteins, the invention provides new methods for analysing complex mixtures of proteins ..." Specification, Page 1, lines 9-14. The claimed library recites specific structural features which enable these methods to be carried out. In this respect, the library is no different than any other material which is used in molecular biology and protein

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chemistry. For example, chromatography materials (such as sepharose, cibacron, blue dextran, etc.) and fluorophores (such as Texas Red, fluorescein, and rhodamine) are utilized in methods of purifying and labeling proteins and DNAs of interest. These uses are substantial and not excluded by any of the uses described on Pages 6-7 of the *Revised Interim Utility Guidelines Training Materials*. Moreover, the Patent Office routinely issues claims covering these categories of materials. For these reasons, it is evident that the claimed subject matter conforms to the statutory requirements. Withdrawal of the rejection is respectfully requested.

**Rejections under §102 and §103**

Claims 1, 2, 5, 6, and 9-15 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Hutchens et al. (WO 98/59360). Claims 1-15 are rejected under 35 U.S.C. §103 as allegedly rendered obvious by Hutchens et al. (WO 98/59360) in view of Markland et al. (WO 92/15679).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Hutchens et al. does not disclose, e.g., a library of proteins where "each of said proteins comprising within its amino acid sequence, or at terminal to it, one or more individual identifier sequence amino acid tracts which are unique to each of said individual proteins when bound to the specific target of interest ..." These features are neither disclosed nor suggested in the cited prior art.

Furthermore, the Office action does not provide any guidance or information on where such aspects are allegedly found in the cited references. Consequently, the claims are not unpatentable in view Hutchins et al. alone, or in combination with Markland et al.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

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The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
Richard M. Lebovitz, Reg. No. 37,067  
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410

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